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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. KENT SIEVERS and DAVID R. HANSEN

Appeal 2007-3633
Application 10/099,789
Technology Center 2100

Decided: May 13, 2008

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-7 and 26-38. The Appellants appeal(s) therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal defines and binds electronic addresses. (Spec. 1.) According to the Appellants, "conventional electronic addressing policies within organizations are based on static policies that cannot be dynamically modified by the organizations." (*Id.* 3.) In contrast, the Appellants' invention "institute[s] dynamic electronic addressing policies . . . ." (*Id.*)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for defining an electronic address, comprising:

selecting a preferred domain name;

selecting one or more additional domain names in addition to the preferred domain name;

selecting a preferred address format;

selecting one or more additional address formats in addition to the preferred address format; and

retaining the preferred domain name, the one or more additional domain names, the preferred address format, and the one or more additional address formats to define the electronic address.

C. REJECTION

Claims 1-7 and 26-38 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application Pub. No. 2003/0115280 ("Quine") and U.S. Patent No. 6,901,436 ("Schneider").

II. CLAIM GROUPING

> "When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2006).

Here, the Appellants argue all the aforementioned claims, which are subject to the same ground of rejection, as a group. (App. Br. 10-12). We select claim 1 as the sole claim on which to decide the appeal of the group. "With this representation in mind, rather than reiterate the positions of the parties *in toto*, we focus on the issues therebetween." *Ex Parte Zettel*, No. 2007-1361, 2007 WL 3114962, at *2 (BPAI 2007).

III. MULTIPLE DATA STRUCTURES

The Examiner finds, "Quine . . . discloses in figure 7, page 8 paragraph [079], a list of multiple prefix formats for an email (the list under items 701 and 702 in figure 7 shows multiple sample addresses for user to select)." (Ans. 7.) The Appellants argue that "multiple different prefix formats cannot be selected to define the email in Quine." (Reply Br. 2.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that Quine selects multiple data structures.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed.Cir. 2003) (internal citations omitted).

A. CLAIM CONSTRUCTION

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "'Where . . . printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.'" *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (quoting *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "Although the printed matter must be considered, in that situation it may not be entitled to patentable weight." *Gulack*, 703 F.2d at 1385.

Here, claim 1 recites in pertinent part the following limitations: "selecting one or more additional address formats . . . ." We view the term "address" as analogous to unpatentable printed matter. Because no routing or delivery is claimed, and the address formats are merely retained, the data representing the address lacks a functional relation. Denying the term patentable weight, the limitations merely require selecting multiple data structures.

B. OBVIOUSNESS ANALYSIS

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, Quine's "FIG. 7 depicts an interface for registering corporate e-mail address formats. . . ." (¶ [0028].) The Appellants admit, "FIG. 7 does present multiple prefix formats. . . ." (Reply Br. 2.) Furthermore, we find that "a plain reading of Quine" (*id.*) reveals that the interface instructs a user to "enter your corporate e-mail address format**(s)**" (Fig. 7 (emphasis added)) and allows him to "Edit Corporate Address Formats." (*Id.* (emphasis added).) The reference' use of the plural in referring to entering and editing address formats, belies the Appellants' attempt to show error in the Examiner's finding that Quine selects multiple data structures.

IV. DATUM

The Examiner makes the following findings.

Quine disclosed a domain of "p[b].com" (see figure 7), which is viewed as a "preferred domain name" and Schneider suggests in

> Col 16 lines 41-57, that when a valid domain name is available for the registration, the additional selection of available fictitious domain name may be concurrently displayed for an potential registrant to register a final selection from the valid or fictitious domain names."

(Ans. 7.) The Appellants argue, "The fictitious domain is not a domain at all it is an alias for but one domain. Consequently, . . . the proposed combination lacks any notion of a 'preferred domain'. . . ." (Reply Br. 2.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that teachings from Quine and Schneider would appear to have suggested selecting a datum.

A. Claim Construction

Although the Appellants argue about the notion of a "preferred domain," claim 1 recites in pertinent part the following limitations: "selecting a preferred domain name. . . ." We view the phrase "preferred domain name" as analogous to unpatentable printed matter. Denying the term patentable weight, the limitations merely require selecting a datum.

B. Obviousness Analysis

The Appellants admit that Quine features a "domain that can be used and that is the domain of the enterprise." (Reply Br. 2.) We agree with the Examiner that the selection of a name for that domain constitutes selecting a datum.

Contrary to the premise of the Appellants' argument, moreover, the claim does not require multiple domains; it merely requires multiple

"domain **names**." (Emphasis added.) For its part, the part of Schneider cited by the Examiner teaches that "all selected TDLA [i.e., top level domain alias] names may be registered . . . ." (Col. 16, ll. 38-39.) The faulty premise of the Appellants' argument and the secondary reference's use of top level **domain** alias **names** undermine the Appellants' attempt to show error in the Examiner's finding that teachings from Quine and Schneider would appear to have suggested selecting a datum.

V. RETAINING PLURAL DATA AND PLURAL DATA STRUCTURES

The Examiner makes the following findings.

> Quine . . . teaches mapping for a definition that maps multiple valid prefixes to a single email definition for a user (see figure 7, item 701, multiple formats are provided with different arrangement of prefixes, e.g. first.last), and Schneider suggests that multiple domains (Col 16 lines 41-57, "example.new", "example.sitemap", etc.) could also be displayed for potential registrant to register a final selection.

(Ans. 8.) The Appellants argue that "there is still no mapping or retention of a definition that maps multiple valid domains and prefixes to a single email definition for a user." (App. Br. 11.) Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that teachings from Quine and Schneider would appear to have suggested retaining plural data and plural data structures to define an additional data structure.

A. CLAIM CONSTRUCTION

Claim 1 recites in pertinent part the following limitations: "retaining the preferred domain name, the one or more additional domain names, the preferred address format, and the one or more additional address formats to define the electronic address." Giving the representative claim the broadest, reasonable construction, the limitations require retaining plural data and plural data structures to define an additional data structure.

B. OBVIOUSNESS ANALYSIS

"[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

As found regarding the first issue, Quine selects multiple data structures, i.e., multiple e-mail address formats. The reference teaches, moreover, retaining these data structures along with data, i.e., domain names, in a "domain name and domain format database 204 . . . ." (¶ [0040].) Each combination of an address format and a domain name defines an additional data structure, viz., an e-mail address.

As found regarding the second issue, Schneider teaches registering plural data, i.e., multiple domain names. Retaining these data is inherent in registering these data.

One of ordinary skill in the art could have used known methods to combine the aforementioned teachings of the two references without changing their respective functions. Such a one would have recognized that result of the combination, viz., retaining plural data and plural data structures to define an additional data structure, was predictable.

"Argument in the brief does not take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773 (CCPA 1964)). Here, the Appellants' allegation that "account[ing] for multiple domains and multiple valid identifiers for a single user" (App. Br. 11) "would not be capable with the existing teachings of Quine" (*id.*) is unsupported by evidence. It shows no error in the Examiner's finding that teachings from Quine and Schneider would appear to have suggested retaining plural data and plural data structures to define an additional data structure.

VI. ORDER

For the aforementioned reasons, we affirm the rejection of claim 1 and of claims 2-7 and 26-38, which fall therewith.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us

nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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